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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,321	12/12/2003	George Trevor Dimond	1209.68785	1363
7590	11/15/2006		EXAMINER	
Lawrence J. Crain Greer, Burns & Crain, Ltd. Suite 2500 300 South Wacker Drive Chicago, IL 60606			LONEY, DONALD J	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 11/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/734,321	DIMOND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Donald Loney	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 33,34,36,37,39-41 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33,34,36,37,39-41 and 43 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 33, 34, 36, 37 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over French (5020256) as presented in the last office action, mailed May 17, 2006.

5. French discloses a handrail 1, a recess 3 (i.e. a channel) therein wherein the recess contains a photo-luminescent printed material 4 that extends below the surface of the channel (i.e. recessed). See column 2, lines 52-64). The printed matter is disclosed as also being a paint or heat stamped to the embodiments of the rail (column 3, lines 41-46 and column 4, lines 13-17). The examiner notes the process limitations in the claims as to the materials being a powder formulation, with carrier, fused to the channel. The examiner deems the final structure of French structurally the same as what would be applicants' final structure since French discloses that their photo-luminescent material 4 is heated as applied to the rail, and would then be fused thereto. The difference between the instant claims and French is that French discloses a clear cover material 6 be placed over the photo-luminescent material. The applicant is attempting to exclude said cover by the amendment to claims 33 and 39 in that the material is uncovered.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to French to remove the cover and its attended function if it is not desired and/or needed to a skilled artisan. It has been held to be within the general skill of a worker in the art to eliminate an element and/or its function as a matter of obvious engineering choice. See *In re Karlson* 136 USPQ 184, "CCPA 1963".

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6. Claims 33, 34, 36, 37 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glatz et al in view of Tassey et al (6237266) as presented in the last office action, mailed May 17, 2006.

Glatz et al discloses a photo-luminescent material 410 entirely contained within channels in a substrate 401. See figures 3, 4, 7, 9 in Glatz et al which shows photo-luminescent material 312,410,708,902 contained within channels in a substrate. The material is mixed with a plastic material (i.e. carrier/fixer), see column 4, lines 11-40. Glatz discloses the material is heated as it is coextrude and then cures thereafter upon cooling, which fuses the material to the channel (column 8, lines 15-26). Glatz et al does fail to disclose the material recessed within the channel.

Tassey et al discloses it is known to recess 22 a photo-luminescent material 20 within a channel in a substrate 12.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Glatz et al to recess the material below the top surface of the channel or depression, as taught by Tassey et al, motivated by the fact this would subject the material to less wear and tear (i.e. direct exposure) since it would be below the top surface of the substrate.

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over either French or Glatz et al in view Tassey et al as applied to claims 33, 34, 36, 37 and 39-41 above, and further in view of the applicant's discussion of the prior art (ADPA) as presented in the last office action, mailed May 17, 2006.

The primary reference or combination teaches the invention substantially as recited except for the substrate being metal. See the 35 U.S.C. 102 rejection above.

The ADPA on page 2, lines 17-19 discusses that it is known to apply photo-luminescent materials to metal substrates.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to form the substrate of metal motivated by the fact the applicant discloses it is known to apply photo-luminescent materials to metals.

### ***Response to Arguments***

Applicant's arguments filed August 21, 2006 have been fully considered but they are not persuasive. The applicant argues there is no incentive or motivation to modify French by excluding the cover layer therein. However, as indicated above it has been held to be within the general skill of a worker in the art to eliminate an element and/or its function as a matter of obvious engineering choice. See *In re Karlson* 136 USPQ 184, "CCPA 1963". The applicant argues that there is no incentive or motivation to modify Glatz as suggested by the examiner since Tassey teaches embroidered photo luminescent thread in the channel. The examiner is not relying on Tassey for the teaching of embroidered material. The primary reference contains a luminescent material as instantly recited. The examiner is only relying on Tassey for the teaching of recessing the photo luminescence material in a channel, so that it is not entirely exposed at the surface, as is instantly claimed.

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8. The AFFIDAVIT under 37 CFR 1.132 filed August 21, 2006 is insufficient to overcome the rejection of claims 33, 34, 36, 37, 39-41 and 43 based upon French or Glatz in view of Tassey as set forth in the last Office action because: The applicant bears the burden of proof of establishing a nexus between the claimed invention and the evidence of commercial success. See MPEP 716.03. The statements as to how much of the product is in the market place and that the commercial success is due to the durability of the product and reduced production costs does not provide sufficient evidence as to the patentability and non obviousness of the invention. One cannot tell if the commercial success is derived from the claimed invention and not from heavy advertising or position as a market leader before the introduction of the product in the market. See MPEP 716.03 (b).

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*D. Loney*  
Donald Loney  
Primary Examiner  
Art Unit 1772

DJL:D.Loney  
11/11/06